Remarks

In response to the Non-Final Office Action mailed July 28, 2008 (hereinafter "Office Action"), claims 1, 64, 65 and 88 have been amended. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. Therefore claims 29, 30, 32, 33, 35, 36, 38, 41-56 and 58-88 are pending.

In view of the foregoing amendments and the following comments, allowance of all the claims pending in the application is respectfully requested.

Interview Summary

As a preliminary matter, Applicant would like to express appreciation for the courtesies extended by Examiner Madamba to Applicant's representative during the Interview conducted on August 19, 2008 (hereinafter the "Interview"). The substance of the Interview is incorporated into the remarks below and constitutes Applicant's record of the Interview.

Rejection under 35 U.S.C. § 103(a)

A.   Claims 29, 30, 35, 36, 38, 41-49, 52-56, 63, 65-74, 77-85 and 87 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 7,206,778 to Bode *et al.* ("Bode") in view of U.S. Patent Application Publication No. 2001/0049688 to Fratkina *et al.* ("Fratkina") and further in view of an article entitles "Evaluating Expertise Recommendations" by David W. McDonald ("McDonald"). Applicant traverses this rejection for at least the following reasons.

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SUMMARY OF OFFICE ACTION

In the Office Action, the Examiner acknowledges that Bode fails to disclose monitoring "a communication *between a user* associated with the remote client *and at least one other individual.*" [Office Action, pg. 8, *emphasis in original; see also* Final Action mailed October 18, 2007, pg. 4,].

The Examiner, however, alleges that Fratkina and McDonald overcome the deficiencies of Bode. In particular, the Examiner alleges:

> Specifically, Fratkina discloses ... a communication *between a user* associated with the remote client *and at least one other individual* [Figs. 19-21] (e.g., Escalation causing a *"live chat"* type of *interaction with a human* to appear within the user's web browser ...) [0225].

> [Office Action, pg. 8, *emphasis in original; see also* Final Office Action mailed October 18, 2007, pg. 4]

The Examiner then concludes:

> It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Bode's invention with the above said feature, as disclosed by Fratkina, *for the motivation of providing a multi-step conversation-like interaction between a person and a computer or other device to refine and satisfy the person's request for information [0005].*

> [Office Action, pg. 8, *emphasis added*].

Next, the Examiner acknowledges that the combination of Bode and Fratkina does not disclose "'automatically monitoring', 'automatically searching', and automatically providing' the search results to said user." [Office Action, pg. 9]. However, the Examiner alleges that:

> McDonald discloses as his invention an Expertise Recommender System (ER) for finding and recommending people who are likely

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to have expertise in a specific problem [Abstract, pg 214] [Paragraphs 2--4, pg. 214]. Specifically, McDonald discloses the above said amended features of 'automatically monitoring', 'automatically searching', and 'automatically providing' the search results to said used (e.g., "automatically assigning incoming calls to an appropriate tech rep", "establishing communications between a support rep and the customer", and "tracking active calls", etc.) [Section 3.1.2 *Tech Support Heuristic*, pg. 217)

[Office Action, pg. 9].

Thus, the Examiner asserts that:

It would thus be obvious to one or ordinary skill in the art at the time of the invention to modify the combination of Bode and Fratkina with the above said feature, as disclosed by McDonald, *for the motivation of providing a system that resolves the problem of identifying and recommending individuals who have expertise* [Abstract] [Introduction] [pg. 214].

[Office Action, pg. 9, *emphasis added*].

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish

a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071,

1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set

forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial

burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of

unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[A] patent composed of

several elements is not proved obvious merely by demonstrating that each of its elements was,

independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396

(2007)(citing United States v. Adams, 383 U.S. 39 (1966)). Rather,

> "....there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'...[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

NEITHER BODE, FRATKINA, NOR MCDONALD, EITHER ALONE OR IN COMBINATION, DISCLOSE OR OTHERWISE RENDER OBVIOUS THE CLAIMED INVENTION

Independent claims 29 and 65 recite, *inter alia*, the features of:

> automatically monitoring, via the first interface, a communication between a user associated with the remote client and at least one other individual;
> automatically filtering one or more topic words appearing in the monitored communication that define a context or one or more key topics of the communication; and
> automatically searching the at least one data source using one or more topic words to generate search results for information relevant to the context or the one or more key topics of the communication.

The claimed invention requires automatically monitoring a communication between

human individuals (i.e., the user and at least one other individual), and automatically providing

search results based on topic words or key topics of the monitored communication. As pointed

out during the Interview, the claimed invention, involves: two human individuals communicating

and an automated monitoring system.

Assuming _arguendo_ that it were legally proper to combine and/or modify the teachings of Bode, Fratkina and McDonald (which Applicants do _not_ concede), the combination of Bode, Fratkina and McDonald fails to disclose or otherwise render obvious each and every feature of at least independent claims 29 and 65.

For example, Bode teaches formulating subsequent searches based on an evaluation of search results in response to a user's query. [_See_ Bode, Abstract]. Thus, as acknowledged by the Examiner, Bode fails to disclose monitoring "a communication _between a user_ associated with the remote client _and at least one other individual._" [Office Action, pg. 8, _emphasis in original; see also_ Final Action mailed October 18, 2007, pg. 4,].

The Examiner, however, asserts "with respect to the Bode prior art, Bode makes it expressly clear that a customer query / inquiry service may involve 'communication' and/or 'interaction' with an automated Customer Relationship Management System (CRM) or a CRM 'application' that is operated by/with 'human application engineers and other customer service personnel' [Bode: col. 1, L25-65]." Applicant disagrees. While Bode does mention, in the Background Section of the patent [_see_ col. 1, lines 25-65], that a user of a CRM system may interact with an automated CRM system (i.e., a machine) or customer service personnel (i.e., a human), the user interacts with either the machine _or_ the human. But Bode does not disclose monitoring a communication between two humans. As such, Bode does _not_ teach automatically monitoring the communication between the user and the human customer service personnel and automatically providing search results based on topic words or key topics of the monitored communication.

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Moreover, while Bode also mentions that "in a CRM system, the user may be forced to place a telephone call to an application engineer or other customer service personnel." [col. 1, lines 61-65], Bode makes no mention or suggestion of automatically monitoring the communication between the user and the human customer service personnel (once the user begins conversing with the human customer service personnel), and automatically providing search results based on topic words or key topics of the monitored communication. Indeed, Bode recognizes that the reason the user is forced to contact the human customer service personnel is because "the CRM application has failed to meet the particular user's needs." [Bode, col. 1, lines 59-60]. It appears that it is the human customer service personnel who further interacts with the user and provides information to the user – not the automated CRM. This, however, is apposite of the claimed invention (i.e., two human individuals communicating and an automated monitoring system).

Fratkina does not overcome the deficiencies of Bode. Rather, Fratkina discloses a dialog engine that facilitates "an electronic interaction *between a human being and a machine* (computer or other device including for example a telephone or Personal Data Assistant)." [Fratkina, ¶ 42], *emphasis added*].

Paragraph [0225] of Fratkina, which is relied upon by the Examiner, recites:

> For example, escalate can cause a 'live chat' type of interaction with a human to appear within the user's web browser or other software client *being used to interact with the dialog engine*. The escalate action can cause some or all of the dialog state information to be forwarded to the human service representative at the other end of the live chat, thus allowing them to provide higher-quality service by knowing what questions, follow-up, documents, etc., *the user has viewed and chosen during the dialog interaction so far*.

[*Emphasis added*]

While the foregoing passage of Fratkina may disclose a communication between individuals (*i.e.*, the user and a human service representative), it appears that the human service representative is merely assisting the user in the user's interaction with the dialog engine. Further, just because Fratkina teaches that a 'live chat' type of interaction with a human may appear within the user's web browser or other software client, it does not follow that the dialog engine is monitoring the 'live chat'. Indeed, the relied-upon passage of Fratkina is silent whether that the dialog engine monitors *any* communication between a user and the human service representative.

Instead, the dialog engine of Fratkina appears only to "[f]ind and route the human to an appropriate web service ... or human expert." [Fratkina, ¶ 44; *see also* ¶ 225 ("The escalate action can cause some or all of the dialog state information to be forwarded to the human service representative at the other end of the live chat, ...") and ¶ 14 (dialog engine provides "instructions to contact a human customer service representative")]. The human service representative appears to be able to converse with the user and *manually* interact with the dialog engine. [*See, e.g.*, Fratkina, ¶ 225 ("... [the human service representative] provide[s] higher-quality service by knowing what questions, follow-up, documents, etc., the user has viewed and chosen during the dialog interaction so far.")].

Moreover, FIGS. 19-21 of Fratkina (which are also cited by the Examiner) appear to illustrate an exemplary analogy of a dialog that occurs when a person walks into a restaurant to order a meal. [*See* Fratkina, e.g., ¶'s [0038] and [0384]]. In particular, Fratkina specifically

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recites: "For the purposes of this example, assume that all service in this particular restaurant are provided by the present invention *with the help of robots* to deliver 'documents' (or dishes) to the customers" [Fratkina, ¶ [0384], *emphasis added*]. Thus, these figures and supporting disclosure are contrary to automatically monitoring a communication <u>between human individuals</u> also.

Further, the Examiner's alleged motivation for the combination of Bode and Fratkina mischaracterizes Applicant's claimed invention. Rather than "providing a multi-step conversation-like interaction **between a person and a computer**," as alleged by the Examiner [Office Action, pg. 8, *emphasis added*], Applicant's claimed invention <u>automatically monitors</u> a communication <u>between human individuals</u>, and automatically provides search results based on topic words or key topics of the monitored communication. As one non-limiting example, the claimed invention may provide search results related to communications between individuals in a business meeting. [*See, e.g.*, Applicant's Specification, ¶ 10].

By contrast, both Bode and Fratkina *teach away* from Applicant's claimed invention. For example, Fratkina teaches a machine for eliciting information from a user to "giv[e] a human feel to the dialog [between a user and a machine]." [Fratkina, ¶ 13]. Bode also teaches that an automated CRM system is a cost-effective alternative to a human customer service personnel. [*See, e.g.*, Bode, col. 1, lines 31-40; lines 64-65]. Indeed, "... when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR*, 82 USPQ2d at 1395 (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)).

In addition, McDonald does not overcome the deficiencies of Bode and Fratkina, either. For example, as pointed out during the Interview, while McDonald may teach that the heuristic is used with a technical support database and that incoming calls may be automatically assigned to an appropriate tech support representative [*see* Section 3.1.2], it appears that incoming calls are assigned after the calls have been entered in the system by the customer support rep. [*Id.* (("*New problems ("calls") can be entered by a support rep* or by customers via email."), *emphasis added*]. Indeed, McDonald also notes:

> The support database was not designed to facilitate the activity of the teach support heuristic. Each query (symptom, customer or program) must be completed separately. *Finding similarities among the three primary characteristics is mostly done in the support representative's head*.
>
> [*Id., emphasis added*].

Thus, like Bode and Fratkina, McDonald does not teach automatically monitoring the communication between the user and at least one individual, and automatically providing search results based on the topic word or key topic of the monitored communication. Further, the Examiner's alleged motivation for the combination of Bode, Fratkina and McDonald also mischaracterizes Applicant's claimed invention. Rather than "**recommending [human] individuals who have expertise,**" as alleged by the Examiner [Office Action, pg. 9, *emphasis added*], Applicant's claimed invention automatically monitors a communication between *human* individuals, and automatically provides search results based on topic words or key topics of the monitored communication.

* * *

For *at least* the foregoing reasons, the rejection of independent claims 29 and 65 under 35 U.S.C. § 103(a) over Bode in view of Fratkina and further in view of McDonald is improper and should be withdrawn. Dependent claims 30, 35, 36, 38, 41-49, 52-56, 63, 66-74, 77-85 and 87 are patentable because they depend from independent claims 29 and 65, as well as for the further features they recite individually.

B.   Claim 32 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bode in view of Fratkina and in further view of McDonald and in further view of U.S. Patent No. 6,976,018 to Teng *et al.* ("Teng"). Claim 33 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bode in view of Fratkina and in further view of McDonald and in further view of U.S. Patent No. 7,185,001 to Burdick *et al.* ("Burdick"). Claims 50, 51, 75 and 76 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bode in view of Fratkina and in further view of McDonald and further in view of the Official Notice taken. Claims 62, 64, 86 and 88 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bode in view of Fratkina and in further view of McDonald and in further view of U.S. Patent No. 5,873,056 to Liddy *et al.* ("Liddy"). Applicant traverses these rejections for at least the following reasons.

Assuming <u>arguendo</u> that it were also legally proper to combine and/or modify the combination of Bode, Fratkina and Burdick with Teng, Burdick, and/or Liddy (which Applicant does <u>not</u> concede), neither Teng, Burdick, nor Liddy, overcome the deficiencies of Bode and Fratkina with regard to independent claims 29 and 65.

For example, Teng, Burdick, Liddy and the Official Notice taken make no mention or suggestion of automatically monitoring, via the first interface, a communication between a user associated with the remote client and at least one other individual, much less automatically filtering one or more topic words appearing in the monitored communication to determine a context or key topics of the communication; and automatically searching the at least one data source for information relevant to the context or key topics of the communication.

For *at least* the foregoing reasons, the rejections of dependent claims 32, 33, 50, 51, 66, 64, 75, 76, 86 and 88 under 35 U.S.C. § 103(a) are improper and should be withdrawn.

Conclusion

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Date: September 3, 2008   Respectfully submitted,

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